

REMARKS

Prosecution was suspended in this application in May 1997 with all claims having been allowed. Prosecution on the merits has now resumed with previously allowed claims being rejected. Each of the Examiner's rejections is addressed in detail below.

Corrected Drawings

The Examiner has indicated that corrected drawings are required to address objections cited on form PTO-948 (applicant acknowledges with appreciation the copy which the Examiner attached to the outstanding Office Action). Pursuant to 37 C.F.R. § 1.85, applicant has submitted herewith formal drawings (Figures 1-13). In these drawing, each of the Draftsperson's objections have been addressed and rectified. Accordingly, applicant requests that formal Figures 1-13 be entered and the objections to the drawings withdrawn.

Claim Rejections

Claims 31, 33 and 34 are pending in this application. They are directed to a method for treating human cancers or tumors.

Claims 31, 33 and 34 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claim 37 of co-pending application 08/253,843 and over claims 31, 33 and 34 of co-pending application 08/449,930. Applicant agrees to file a terminal disclaimer, or to cancel or to amend the claims, as appropriate, to obviate this obviousness-type double patenting rejection upon allowance of any of the conflicting claims.

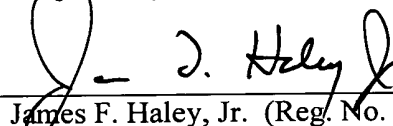
Claims 31 and 34 stand rejected under 35 U.S.C. § 102(e) (prior to amendment by the AIPA) as anticipated by one of Sugano et al. (U.S. Patent 5,514,567) or Sugano et al. (U.S. Patent 5,326,859). According to the Examiner, each Sugano patent discloses a DNA sequence (Table 5), which differs by only one nucleotide (a silent difference at codon 30) from the DNA recited in the instant application and claims (claim 31). Thus, according to the Examiner, Sugano's DNAs would hybridize to the DNA sequences recited in claim 31 and would encode the same amino acid sequence as recited in claim 34 of the instant application. The Examiner further contends that methods taught in each of the Sugano references are embraced by claims 31 and 34 of the instant application. Applicant traverses. Neither Sugano patent is 102(e) prior art to this application.

This application is entitled to benefit, under 35 U.S.C. § 119, from the filing dates of two Great Britain priority applications. The first priority application, filed April 3, 1980 (GB 8011306), disclosed the cloning and sequencing of DNA encoding human IFN- β . The second priority application, filed June 6, 1980 (GB 8018701), disclosed the expression from those DNA sequences of polypeptides having the biological and immunological activity of human IFN- β .

Accordingly, the claims of this application, each of which is directed to a method of treating human cancers or tumors, are thus entitled to an effective filing date no later than June 6, 1980. This predates the earliest United States filing date (October 27, 1980) to which either of the Sugano patents is entitled under section 102(e). Accordingly, neither of the Sugano patents is 102(e) prior art. Applicant, therefore, respectfully requests that the Examiner withdraw the rejections.

For all the above reasons, re-consideration and allowance of the pending claims is requested.

Respectfully submitted,



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